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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,409	10/30/2001	Kenneth J. Wilson	1521-251US	8743

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

TAYLOR, NICHOLAS R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/020,409

Applicant(s)

WILSON, KENNETH J.

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8, 9, 13, 15-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 8, 9, 13, 15-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 3-5, 8, 9, 13, 15-18, and 20-25 have been presented for examination and are rejected.

#### ***Response to Arguments***

2. Applicant's arguments filed 4/20/2005 with respect to claims 3-5, 8, 9, 13, 15-18, and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 8 depends on cancelled claim 6. For the purposes of this office action, it is interpreted that claim 8 correctly depends on claim 21.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 3-5, 8, 9, 13, 15-18, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Skladman et al. (US Patent 6,400,810.)

7. As per claims 21 and 22, Skladman teaches a system comprising an e-mail server and at least one computer connected to the server, (Skladman, figure 1) a method for alerting a user to the receipt in an e-mail server of mail message having predetermined contents comprising the steps of:

receiving the e-mail message in the server;

storing the e-mail message in a mailbox corresponding to the user;

scanning the e-mail message stored in the mailbox to determine if a text string within the e-mail message meets a predetermined outcome criteria; and

activating an annunciator if the text string meets the predetermined outcome criteria (Skladman, column 2, lines 22-45.)

8. As per claim 3, Skladman teaches the system further wherein the text string comprises a "from" address (Skladman, column 2, line 66 to column 3, line 13.)

9. As per claim 4, Skladman teaches the system further wherein the text string includes a "from" address and a text string other than the "from" address (Skladman, column 2, line 66 to column 3, line 13.)

10. As per claim 5, Skladman teaches the system further wherein the text string includes a "from" address and an "urgent" flag (Skladman, column 2, line 66 to column 3, line 13.)

11. As per claim 8, Skladman teaches the system further including the step of forwarding the message to an addressee (Skladman, column 3, lines 33-46.)

12. As per claim 9, Skladman teaches the system further including the step of the server receiving a description of the predetermined outcome criteria from the at least one computer (Skladman, column 3, lines 48-61 and figure 2.)

13. As per claim 13, Skladman teaches the system further wherein the program code further includes code for activating an annunciator if the e-mail message meets the predetermined outcome criteria (Skladman, column 2, lines 22-45.)

14. As per claim 15, Skladman teaches a method for interacting with a client computer and setting outcome criteria and outcome instructions in an e-mail server connected to the client computer, the method comprising:

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logging in to the e-mail server with a user-name;  
receiving a configuration page from the e-mail server;  
entering the outcome criteria into the configuration page;  
entering an instruction for activating an annunciator, into the configure page; and  
submitting the configuration page to the e-mail server (Skladman, column 3, lines 48-61 and figure 2.)

15. As per claim 16, Skladman teaches the system further wherein the outcome criteria comprises a "from" address (Skladman, column 2, line 66 to column 3, line 13.)

16. As per claim 17, Skladman teaches the system further wherein the outcome criteria includes a text string (Skladman, column 2, line 66 to column 3, line 13.)

17. As per claim 18, Skladman teaches the system further wherein the outcome criteria includes an "urgent" flag (Skladman, column 2, line 66 to column 3, line 13.)

18. As per claim 20, Skladman teaches the system further wherein the outcome instructions include the address of an addressee for receiving the e-mail message (Skladman, column 2, line 66 to column 3, line 13.)

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19. As per claim 23, Skladman teaches the system further wherein the server receives a description of the predetermined outcome criteria from the at least one computer (Skladman, column 3, lines 48-61 and figure 2.)

20. As per claim 24, Skladman teaches the system further wherein the annunciator provides a visual alert (Skladman, figure 4.)

21. As per claim 25, Skladman teaches the system further wherein the annunciator provides an audio alert (Skladman, figure 4.)

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor  
Examiner  
Art Unit 2141

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER